

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERNEST F. LARSEN

Appeal No. 1999-0652
Application No. 08/699,262¹

ON BRIEF

Before PATE, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed August 19, 1996.

BACKGROUND

The appellant's invention relates to a lock pick assembly. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Di Stefano	1,701,771	Feb. 12, 1929
Bross	3,174,462	Mar. 23, 1965

The following rejections are before us for review.

Claims 1 through 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Di Stefano in view of Bross.

Reference is made to the brief (Paper No. 9) and reply brief (Paper No. 11) and the final rejection (Paper No. 5) and answer (Paper No. 10) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

The appellant alleges on pages 1 and 2 of the reply brief that the examiner has, by citing new prior art references for the first time in the answer, impermissibly set forth a new ground of rejection and requests (reply brief, page 3) that

"this application be remanded with instructions that a different examiner start the examination process anew." In that we exercise no general supervisory power over the examining corps, we decline to remand the application with such instructions. The relief sought by appellant would appear to have properly been presented by petition to the Commissioner under 37 CFR § 1.181. Moreover, with regard to the allegation that the examiner's answer contains a new ground of rejection, even if the appellant is correct in this regard, the appellant has not been prejudiced thereby, in view of our treatment of the examiner's rejection set forth below.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims 1 through 3 under 35 U.S.C. § 103, the examiner asserts that Di Stefano discloses all of the elements of the claimed invention except an L-shaped tension

tool. It is the examiner's position, however, that Bross teaches an L-shaped tensioned clip secured through an aperture of a tube (1) and held in place by the threaded member (3) (answer, pages 3 and 4). According to the examiner,

[i]t would have been obvious to one of ordinary skill in the art to add a removable clip like that taught in Bross to the retractable pick member of Di Stefano at cap 4 when it is desired to clip the device of Di Stefano to a user's pocket in a manner similar to that set forth in Bross. It would have been an obvious matter of design choice to one of ordinary skill in the art to extend the clip approximately to the proximal end of the tube 1 of Di Stefano since the longer the clip the more securely it will be held in the user's pocket. The pick and clip of modified Di Stefano are capable of use as a lock pick and tension tool in much the same manner as a bobby pin and paper clip are capable for use as lock picking or tensioning tools [answer, page 4].

The appellant argues that Di Stefano, which particularly discloses a retractable ice pick, does not mention use of the retractable tool disclosed therein as a lock pick and that, accordingly, the tool is not a "lock pick" (brief, pages 5 and 6). The appellant further argues that the Bross clip is not secured through an aperture of the tube (1) and that, in fact, there is no aperture in the tube (brief, page 6).

From our viewpoint, a "lock pick tool" is any pointed tool capable of being used to open a lock without a key.² The examiner has asserted that the retractable tool of Di Stefano is capable of use as a lock pick (final rejection, page 3, and answer, page 4). As the Di Stefano tool is elongate and pointed, and thus capable of insertion into a lock, we find the examiner's assertion to be reasonable, thus establishing a *prima facie* case that the Di Stefano tool is a "lock pick tool" as claimed. The examiner's assertion in the final rejection thus shifted the burden to the appellant to show that the Di Stefano tool did not inherently possess such capability. See In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

In response, the appellant has merely alleged that the examiner's assertion is "fiction and fantasy" (brief, page 4), but has not offered any explanation as to why the pick tool of Di Stefano is not capable of use in picking locks. We do not find this allegation persuasive.

² A "pick" is defined as "any of several pointed tools or instruments for picking" and the verb "to pick" is defined as "to open (a lock) as with a wire instead of a key, esp. in a stealthy manner" Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

We do, however, agree with the appellant that Bross discloses neither an aperture in the tube (tubular barrel 1) proximate the distal end of the tube (the end opposite the open end from which the writing cartridges may be extended) nor a clip in the form of "a generally L-shaped tension tool" having a shorter leg "constructed and configured to extend through" such an aperture. Rather, the Bross clip is illustrated, in the Figure 1 embodiment, as comprising a ring sandwiched between the distal end face of the tubular barrel (1) and the flange of a threaded connector (3) and, in the Figure 4 embodiment, as comprising a ring disposed in an annular groove or recess in a tubular collar (130). Thus, even if Bross would have suggested providing a tension clip on the Di Stefano barrel, the combined teachings of Di Stefano and Bross lack a suggestion to provide an aperture in the barrel proximate the distal end thereof for passage of the shorter leg of the clip and to configure the tension clip as "a generally L-shaped tension tool."³

³ A "tension tool" as described in the appellant's specification is a tool having a shorter leg which is inserted into the lock plug to apply tension to the plug, presumably by using the longer leg as a lever arm. A clip, such as that taught by Bross, having a ring attached to the shorter leg

(continued...)

Moreover, the distinction between the clip design and attachment taught by Bross and the claimed arrangement is significant to the appellant's invention. Specifically, by means of the claimed L-shaped tension tool configuration and the removable attachment means, the tension tool serves a dual function as a clip to facilitate carriage of the tool in a shirt pocket and as a tension tool for tensioning the lock plug when the lock pick is in use.

For the foregoing reasons, we cannot sustain the examiner's rejection of claim 1, and claims 2 and 3 which depend therefrom, under 35 U.S.C. § 103.⁴

³(...continued)
would not, in our opinion, be capable of such use.

⁴ We note, for the record, that we consider the Kern, Corcoran and Cooke references cited in the answer as evidence that paper clips and bobby pins were known at the time of the appellant's invention for use in picking locks to be irrelevant to the issue of patentability of the claims on appeal over Di Stefano in view of Bross, for the reasons discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 3 under 35 U.S.C. § 103 is reversed.

REVERSED

WILLIAM F. PATE, III)
Administrative Patent Judge)
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LAWRENCE J. STAAB) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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JENNIFER D. BAHR)
Administrative Patent Judge)

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GRANT L HUBBARD
10711 EAST MERCURY DRIVE
APACHE JUNCTION, AZ 85220